

### **IN THE DRAWINGS**

Please replace the original Figure 1 with the replacement sheet having a replacement Figure 1. A “1” has been place in front of each reference numeral in Figure 1 to distinguish the enumerated elements from those shown in Figure 2.

### **REMARKS**

Claims 1-54 were pending in the application prior to the foregoing amendment. Claims 1-54 stand rejected. Claims 1-26 and 28-54 remain pending in the application after entry of the foregoing amendment. Claim 27 has been canceled, and claims 1, 26, 28, 42, 51, and 53 have been amended. Claim 26, as now amended, incorporates the features of original claim 27.

Applicant respectfully submits that the change to Figure 1, along with the corresponding amendments to the specification to conform with the new reference numerals, remedies the objection to the drawings raised in the office action.

No new matter has been added.

### **35 USC § 102(b) Rejection (LaCourse)**

Claims 1, 5-11, 26, 28, 30, 32, 34, 36-42, 44-47, 49, 51, and 53 stand rejected as allegedly being anticipated under § 102(b) by U.S. Patent No. 5,002,065 (*LaCourse*).

### **Claims 1 and 5-11**

With regard to claims 1 and 5-11, Applicant respectfully submits that *LaCourse* does not teach an apparatus having a first component for transmitting or receiving a remote electronic communication signal and a second component for generating a vibration to be used in medical diagnosis, wherein the second component generates vibration independently from the electronic signal transmitted to or received by the first component, as recited by the herein amended claims.

It is well settled that a reference must teach every element or aspect of the claim in order to be considered as prior art under § 102(b). MPEP 706.02(IV). The present invention, as recited in claim 1 and 5-11, teaches an apparatus that comprises two components for performing two separate and independent functions: remote electronic communication and medical diagnosis. In contrast, *LaCourse* teaches only one component that does not perform all of the functions claimed in the present invention.

Specifically, *LaCourse* uses a single component, the tool (103), which receives an electronic signal and generates a vibration that is used for medical diagnosis. The tool (103) is incapable of transmitting a remote electronic communication. Moreover, the tool (103)

generates vibration in response to the electronic signal and not independently therefrom. Thus, the device of *LaCourse* fails to teach every element claimed in the present invention.

Because *LaCourse* does not teach an apparatus wherein a vibration for use in medical diagnosis is generated independently from a transmitted or received remote electrical communication signal, *LaCourse* does not anticipate the present invention and should not be considered prior art under § 102(b) as to claims 1 and 5-11.

With regard to claim 26, Applicant respectfully submits that *LaCourse* does not teach an apparatus that functions as a pager, beeper, or cellular phone, as recited in the herein amended claim. Therefore, because it does not teach every element of the claim, *LaCourse* does not anticipate and should not be considered prior art under § 102(b) as to claim 26.

Accordingly, Applicant respectfully requests that the anticipation rejections over *LaCourse* be withdrawn with respect to claims 1, 5-11, and 26.

**Claims 28, 30, 32, 34, 36-41, 42, 44-47, 51, and 53**

With regard to claims 28, 30, 32, 34, 36-41, 42, 44-47, 49, 51, and 53, Applicant respectfully submits that *LaCourse* does not teach a method using a first component for transmitting or receiving a remote electronic communication signal and a second component for generating a vibration to be used in medical diagnosis, wherein the second component generates vibration independently from the electronic communication signal received or transmitted by the first component, as recited by the herein amended claims.

It is well settled that a reference must teach every element or aspect of the claim in order to be considered as prior art under § 102(b). The present invention, as recited in the claims, teaches a method that comprises performing two separate and independent functions: medical diagnosis and remote electronic communication. In contrast, *LaCourse* teaches a method wherein one component generates a vibration used in medical diagnosis in response to an electronic signal received by the component. *LaCourse* fails to teach a method wherein a second component generates vibration that is independent from the electronic signal received by the component used in medical diagnosis.

Because *LaCourse* does not teach a method wherein vibration is generated independently from a transmitted or received remote electrical communication signal,

*LaCourse* does not anticipate and should not be considered prior art under § 102(b) as to claims 28, 30, 32, 34, 36-41, 42, 44-47, 49, 51, and 53.

Accordingly, Applicant respectfully requests that the anticipation rejection over *LaCourse* be withdrawn with respect to claims 28, 30, 32, 34, 36-41, 42, 44-47, 49, 51, and 53.

**35 USC § 102(e) Rejection (*Campbell*)**

Claims 1-27 stand rejected as allegedly being anticipated under § 102(e) by U.S. Patent Application No. 2003/0060765 (*Campbell*).

The office action asserts that *Campbell* includes a component for generating vibration to be used in a medical diagnosis. Applicant respectfully submits that the office action mischaracterizes the teachings of *Campbell*. Generally, the device disclosed in *Campbell* is therapeutic and not diagnostic; it is used for infusion of medicine into a patient and not for medical diagnosis of a condition of a patient. More specifically, the sole purpose of the vibrator (36) in *Campbell* is to provide feedback to an individual about the operational state of the device, and not to perform any sort of medical diagnosis [0056].

Tellingly, the office action provides no citation for the contention that “[w]hen the apparatus is applied to a subject, threshold for the perception or disappearance of vibration can be determined as a measure of nerve function to detect neuropathy.” That is because *Campbell* contemplates or discloses no such diagnostic use. The part of the *Campbell* device that is applied to a subject is not the same part that generates the vibration. Additionally, *Campbell* makes no connection between a patient’s perception of vibration and any sort of nerve function or neuropathy. Indeed, the words threshold, perception, disappearance, vibration, nerve, neuropathy, and diagnosis do not appear anywhere in *Campbell*. Clearly, the *Campbell* device has nothing to do with medical diagnosis, as distinguished from the present invention which is used for medical diagnosis. Therefore, for the foregoing reasons, *Campbell* cannot anticipate and should not be considered prior art under § 102(e) in regard to claims 1-27.

### **Claims 1-13**

Further, specifically with regard to claims 1-13, Applicant respectfully submits that *Campbell* does not teach an apparatus having a first component for transmitting or receiving a remote electronic communication signal and a second component for generating a vibration to be used in medical diagnosis, wherein the second component generates vibration independently from the electronic signal transmitted to or received by the first component, as recited by the herein amended claims. Rather, *Campbell* teaches one component for generating a vibration in response to an electronic signal transmitted to and received by the component, the vibration having no connection whatsoever to medical diagnosis.

It is well settled that a reference must teach every aspect of the claim in order to be considered as prior art under § 102(e). Because *Campbell* does not teach the generation of a vibration independently from a transmitted or received remote electrical communication signal, *Campbell* cannot anticipate and should not be considered prior art under § 102(e) in regard to claims 1-13.

### **Claims 14-25**

Further, specifically with regard to claims 14-25, Applicant respectfully submits that *Campbell* does not teach an apparatus comprising a device for generating vibration in first and second modes, one of said first and second modes for utilizing in an electronic communication and the other of said first and second modes for utilizing in a medical diagnosis, as recited in the original claims. Rather, *Campbell* teaches one component for generating a plurality of vibrational modes in response to an electronic signal transmitted to and received by the component, none of the vibrational modes having any connection whatsoever to medical diagnosis.

It is well settled that a reference must teach every aspect of the claim in order to be considered as prior art under § 102(e). Because *Campbell* does not teach the generation of a vibrational mode used for medical diagnosis, *Campbell* cannot anticipate and should not be considered prior art under § 102(e) in regard to claims 14-25.

### **Claims 3, 14, 15, and 26**

Further, specifically with regard to claims 3, 4, 15, and 26, the office action incorrectly asserts that the device of *Campbell* functions as a pager, beeper, or cellular phone. Applicant respectfully submits that office action has mischaracterized the teachings of *Campbell*. In fact, the only mention of “phone” in *Campbell* is as a remote input device for use in programming the device that is the subject of the invention [0054]. The office action points to paragraph [0061], which merely makes an unspecific reference to remote programming of the device. Neither of these portions of disclosure support the office action’s assertion that *Campbell* discloses a device functioning as a pager, beeper, or cellular phone. Rather, the *Campbell* device does not function as a pager, beeper or cellular phone, and the disclosure makes no mention of any such devices.

It is well settled that a reference must teach every aspect of the claim in order to be considered as prior art under § 102(e). Because *Campbell* does even mention or imply the functionality of a pager, beeper, or cellular phone, as recited in the herein amended claim, *Campbell* cannot anticipate and should not be considered prior art under § 102(e) in regard to claims 3, 4, 15, and 26.

Accordingly, Applicant respectfully requests that the anticipation rejection over *Campbell* be withdrawn with respect to claims 1-27.

### **35 USC § 103(a) Rejection (LaCourse in view of Laudadio)**

Claims 31, 33, 35, 48, and 50 stand rejected as allegedly being anticipated under § 103(a) by U.S. Patent No. 5,002,065 (*LaCourse*) in view of U.S. Patent No. 5,931,793 (*Laudadio*).

Applicant respectfully submits that the office action does not establish a *prima facie* case of obviousness with regard to claims 31, 33, 35, 48, and 50. A *prima facie* case of obviousness requires that all claim limitations be taught or suggested in the prior art. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); *In re Royka*, 490 F.2d 981 (CCPA 1974). The office action asserts that *Laudadio* discloses grading a vibration threshold as low, medium, or high when compared to a preset standard, making up for the failure of *LaCourse* to grade the vibration threshold in making a medical diagnosis.

Even if *Laudadio* discloses the grading of a vibration threshold, an obviousness rejection under § 103(a) fails because, as discussed above, *LaCourse* does not disclose every element of the as-claimed invention, and *Laudadio* does not remedy this deficiency. Therefore, *LaCourse* in view of *Laudadio* cannot render obvious claims 31, 33, 35, 48, and 50.

Accordingly, Applicant respectfully requests that this rejection be withdrawn with respect to claims 31, 33, 35, 48, and 50.

**35 USC § 103(a) Rejection (*LaCourse* in view of *Causey*)**

Claims 2, 29, 43, 52, and 54 stand rejected as allegedly being anticipated under § 103(a) by U.S. Patent No. 5,002,065 (*LaCourse*) in view of U.S. Patent No. 6,641,533 (*Causey*).

Applicant respectfully submits that the office action does not establish a *prima facie* case of obviousness with regard to claims 2, 29, 43, 52, and 54. A *prima facie* case of obviousness requires that all claim limitations be taught or suggested in the prior art. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); *In re Royka*, 490 F.2d 981 (CCPA 1974). The office action asserts that *Causey* teaches the alternative use of wired or wireless signals, making up for the failure of *LaCourse* to disclose anything other than wired signals.

Even if *Causey* teaches that electronic signals can be equivalently transferred over a wire or wirelessly, an obviousness rejection under § 103(a) fails because, as discussed above, *LaCourse* does not disclose every element of the as-claimed invention, and *Causey* does not remedy this deficiency. Therefore, *LaCourse* in view of *Causey* cannot render obvious claims 2, 29, 43, 52, and 54.

Accordingly, Applicant respectfully requests that this rejection be withdrawn with respect to claims 2, 29, 43, 52, and 54.

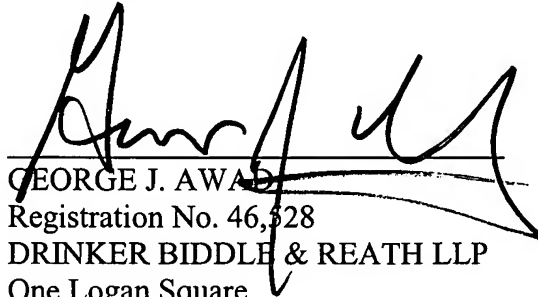
**CONCLUSION**

For all of the foregoing reasons, the application is in condition for allowance. Withdrawal of all objection and rejections, and allowance of claims 1-26 and 28-54 is respectfully requested. An early notice of allowance of those claims is earnestly solicited.

Respectfully submitted,

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## ATTACHMENTS

- Replacement Sheet for Figure 1